

Application No. 08/480,641
Amendment dated March 30, 2007
Reply to Office Action of January 24, 2007

Examiner made a restriction requirement between: (1) claims 90 and 140; and (2) claims 95-139.

On March 11, 1999, in response to the Restriction Requirement, Applicant elected claims 95-139 for prosecution on the merits and further elected claims 90 and 140 pursuant to 37 C.F.R. 1.129(b) and submitted the fee under 37 1.17(s) for the additional group elected.

In the Office Action dated September 2, 1999, the Examiner objected to claims 102-107, 114, 115, 122, 123, 128, 131, and 138 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner rejected claims 95-101, 108-113, 116-121, 124-127, 129, 130, 132-136, and 139 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,878,915 to Brantigan; and rejected claim 137 under 35 U.S.C. § 103(a) as being unpatentable over Brantigan in view of U.S. Patent No. 4,772,286 to Goble. The Examiner indicated that claims 90 and 140 were withdrawn from consideration without any explanation.

On February 28, 2000, in reply to the Office Action, Applicant submitted remarks responding to the Examiner's rejections. In the Office Action dated January 26, 2001, the Examiner repeated the same objections and rejections of the claims set forth in the Office Action dated September 2, 1999 with no new grounds of rejection.

On July 26, 2001, Applicant filed a reply to Office Action rewriting claims 102, 114, 115, 131, and 138 in independent form as suggested by the Examiner and adding claims 141-236 dependent off each of the rewritten independent claims, respectively. Applicant amended independent claims 136 and 139, informed the Examiner that claims 90 and 140 were improperly withdrawn, and that Applicant was entitled to have these claims examined on the merits.

In the Office Action dated September 18, 2001, the Examiner indicated that claims 90, 95-140 and 141-236 were pending in the application. Claims 102-107, 114, 115, 122, 123, 128, 131, 138, and 141-236 were allowed. Claims 95-101, 108-113, 116-121, 124-127, 129, 130, and 132-136 were rejected under 35 U.S.C. § 102(b) as

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being anticipated by U.S. Patent No. 4,878,915 to Brantigan; and claim 137 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brantigan in view of U.S. Patent No. 4,772,286 to Goble.

On March 18, 2002, Applicant filed a Notice of Appeal, Reply to Office Action, and Request for Withdrawal of Improper Finality. Applicant amended independent claims 95 and 108 to address the Examiner's concern that parts of the human anatomy were being claimed as expressed during a telephonic interview on October 1, 2001.

On June 11, 2002, the Examiner mailed an Advisory Action indicating that claims 102-107, 114, 115, 122, 123, 128, 131, 138, and 141-226 [sic] were allowed and claims 95-101, 108-113, 116-121, 124-127, 129, 130, and 132-137 were rejected. Also included were 18 pages of Form PTO1449s initialed by the Examiner.

On October 7, 2002, Applicant's representative conducted a telephone interview with the Examiner to discuss the status of Applicant's Request for Withdrawal of Improper Finality and the status of claims 90 and 227-236. The Examiner agreed with Applicant's Request and told Applicant's representative not to file an Appeal Brief and that he would consider a new Office Action on the merits. On October 18, 2002, Applicant filed a communication confirming the substance of the telephone interview with the Examiner.

On November 21, 2002, in an Examiner Interview Summary, the Examiner indicated that the "final rejection of Paper No. 23 will be withdrawn and a non final rejection will be sent out within the next two weeks."

On August 6, 2004, Applicant filed a Status Inquiry as no further communication from the Examiner had been received since the Examiner indicated that the finality of Paper No. 23 would be withdrawn.

On October 21, 2004, Applicant filed an amendment adding claims 237-240 and a Request for Interference under 37 C.F.R. 41.202(a).

In the Office Action dated April 6, 2005, the Examiner allowed claims 114, 115, 138, and 237-240; objected to claims 104, 107, 122, 123, 128, 133, 134, 141-180, 186, 187, 194, 195, 200, 204, 208, 214, 215, 222, 223, and 235 as being dependent upon a

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rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the claim and any intervening claims; rejected claims 95-97, 99-103, and 106 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,545,374 to Jacobson; rejected claims 95-101, 108-113, 116-121, 124-127, 129-132, 135, 136, 139, 181-185, 188-193, 196-199, 201-203, 205, 206, 209-213, 216-221, 224-233, and 236 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,878,915 to Brantigan; and rejected claim 137, 207, and 234 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,878,915 to Brantigan in view of U.S. Patent No. 4,772,286 to Goble.

On October 5, 2005, in reply to the Office Action, Applicant submitted remarks responding to the Examiner's rejections, amended claim 236, and added dependent claim 241.

In the Office Action dated December 27, 2005, the Examiner allowed claims 114, 115, 131, 138, 141-180 and 237-240; objected to claims 104, 107, 122, 123, 128, 133, 134, 186, 187, 194, 195, 200, 204, 208, 214, 215, 222, 223, and 235 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the claim and any intervening claims; rejected claims 95-101, 108-113, 116-121, 124-127, 129, 130, 132, 135, 136, 139, 181-185, 188-193, 196-199, 201-203, 205, 206, 209-213, 216-221, 224-233, 236, and 241 under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 4,878,915 to Brantigan; and rejected claim 137, 207, and 234 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,878,915 to Brantigan in view of U.S. Patent No. 4,772,286 to Goble.¹

On April 5, 2006, Applicant filed a reply to Office Action submitting remarks addressing the Examiner's rejections.

¹ Dependent claims 181-208 and 241 were objected to or rejected by the Examiner in the Office Action dated December 27, 2005. However, these claims depend from allowed independent claims 131 or 237, or claims depending therefrom, and should also be allowable at least due to their dependency from an allowed independent claim.

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On June 27, 2006, Applicant filed a Notice of Appeal and a Pre-Appeal Brief Request for Review.

On October 31, 2006, pursuant to the Examiner's request, Applicant filed a current listing of pending claims.

In the Notice of Panel Decision from Pre-Appeal Brief Review dated November 7, 2006, the Examiner's rejections were withdrawn and a new Office Action was ordered to be mailed by the Examiner.²

In the Office Action dated January 24, 2007, the Examiner rejected all the claims of the application under 35 U.S.C. § 112, second paragraph, for undue multiplicity.

Arguments

Regarding the rejection in the outstanding Office Action, the Examiner indicated that "where, in view of the nature and scope of applicant's invention, applicant presents an unreasonable number of claims which are repetitious and multiplied, the net result of which is to confuse rather than to clarify, a rejection on undue multiplicity...may be appropriate." Applicant respectfully disagrees with the undue multiplicity rejection under 35 U.S.C. § 112, second paragraph.

All Pending Claims have already been Examined by the Examiner

The prosecution history of the present application shows that all of the pending claims (except for dependent claim 241) have been substantively examined at least twice by the Examiner. In the past, the Examiner has not found the number of claims presented to be unreasonable or confusing. To the contrary, the Examiner previously allowed a majority of the independent claims and claims dependent therefrom.

² At the time of the Notice of Panel Decision from Pre-Appeal Brief Review, independent claims 114, 115, 131, 138, and 237, and claims 141-180 and 238-240 depending from independent claims 114, 115, 131, 138, or 237, or claims dependent therefrom, had been allowed by the Examiner; claims 181-208 and 241 depending from independent claims 131 or 237, or claims dependent therefrom, are allowable at least because of their dependency from allowed independent claims; and the Examiner's rejection of independent claims 95, 102, 108, and 139, and claims 96-101, 103-107, 109-113, 116-130, 132-137, and 209-236 depending from independent claims 95, 102, 108, or 138, or claims dependent therefrom, had been withdrawn.

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Specifically, independent claims 114, 115, 131, 138, and 237 have been allowed by the Examiner. Furthermore, claims 141-180 and 238-240 depending from independent claims 114, 115, 131, 138, or 237, or claims dependent therefrom, have been allowed by the Examiner, and claims 181-208 and 241 depending from independent claims 131 or 237, or claims dependent therefrom, are allowable at least due to their dependency from an allowed independent claim. (See Office Action dated December 27, 2005). Accordingly, a majority of the claims have been allowed or depend from allowed claims.

Pre-Appeal Brief Conference Results in Withdrawal of all Rejections

Since the Office Action of December 27, 2005, Applicant made no changes to the pending claims. Applicant utilized the Pre-Appeal Brief Conference procedure and prevailed in having the Examiner's remaining prior art rejections of the claims withdrawn. Specifically, the prior art rejection of independent claims 95, 102, 108, and 139 was withdrawn in a Pre-Appeal Brief Conference. (See Notice of Panel Decision from Pre-Appeal Brief Review of November 7, 2006). As such, independent claims 95, 102, 108, and 139, and claims 96-101, 103-107, 109-113, 116-130, 132-137, 209-236, and 241 depending from independent claims 95, 102, 108, or 138, or claims dependent therefrom, appear to be in condition for allowance. In the absence of any valid art rejection of the pending claims, Applicant submits that a Notice of Allowance is merited. Therefore, given the status of the pending claims, Applicant traverses the Examiner's timing and grounds for an undue multiplicity rejection.

In the Office Action, the Examiner indicates that, "if an undue multiplicity rejection is appropriate, the examiner should contact applicant by telephone explaining that the claims are unduly multiplied." In doing so, the Examiner states that Applicant should be requested to select a specified number of claims. In the present case, the Examiner has neither spoken with Applicant or its representatives about the possibility of an undue multiplicity rejection nor has specified the number of claims the Examiner would consider suitable for further consideration. For example only, if the Examiner were to suggest that a suitable number for further consideration is at least twenty

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claims, then, given that independent claims 114, 115, 131, 138, and 237 have already been allowed and accordingly need no further examination, Applicant submits that the remaining independent claims (claims 95, 102, 108, and 138) and selected claims dependent therefrom could readily be examined within such constraints.

Dependent Claims Directed to Subject Matter Already Examined and Deemed Allowable

A substantial number of dependent claims are directed to subject matter already examined and determined to be allowable by the Examiner. Table 1 attached hereto, shows the status of the claims prior to the Pre-Appeal Brief Conference based on the Office Action dated December 27, 2005. The columns correspond to independent claims 95, 102, 108, 114, 115, 131, 138, 139, and 237, respectively. The rows include the claims dependent from each of the independent claims or claims dependent therefrom. Dependent claims in the same row are directed to the same subject matter. The rows and columns for the allowed claims are shaded in grey.³

For all but one of the remaining rejected dependent claims, as shown in Table 1, the subject matter of the dependent claims corresponds to the same subject matter of dependent claims 181-207 dependent from allowed independent claim 131 and dependent claims 143, 152, and 153 dependent from allowed independent claim 114 indicated to be allowed by the Examiner. Since the Examiner has already examined the subject matter of these claims and determined it is allowable, no additional burden is being placed on the Examiner.⁴

Five Independent Claims were Objected to Dependent Claims Rewritten in Independent Form

In response to the Examiner's indication of allowed subject matter, Applicant rewrote several dependent claims in independent form. Specifically, independent

^{3, 4} As shown in Table 1, independent claims 114, 115, 131, 138, and 237, and claims 141-180 and 237-240 depending from independent claims 114, 115, 131, 138, or 237, or claims dependent therefrom, were allowed by the Examiner, and claims 181-208 and 241 depending from independent claims 131 or 237, or claims dependent therefrom, are allowable at least due to their dependency from an allowable independent claim.

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claims 102, 114, 115, 131, and 138 were originally dependent claims that the Examiner objected to as being dependent upon a rejected base claim, but indicated would be allowable if rewritten in independent form. The Examiner's previous substantive examination of the claims has directly resulted in the number of independent claims being increased. Therefore, Applicant submits that the Examiner should be precluded from now arguing that the number of claims presented is unreasonable.

Undue Multiplicity Rejections Severely Cut Back by USPTO

In support of the undue multiplicity rejection, the Examiner has relied upon In re Chandler, 319 F.2d 211, 138 U.S.P.Q. 138 (CCPA 1963). However, Applicant notes that the Patent Office has recently considered the issue of undue multiplicity. In doing so, the Patent Office indicated that in decisions following In re Chandler, "the CCPA has declined to hold that the presentation of any particular number of claims is so excessive as to confuse or obscure the inventions defined by the claims." (See USPTO Changes to Implement Business Goals, Part II, October 05, 1998, Federal Register, Vol. 63, No. 192). The Patent Office has also indicated that decisions such as In re Flint, 411 F.2d 1353, 162 U.S.P.Q. 228 (CCPA 1969), and In re Wakefield, 422 F.2d 897, 164 U.S.P.Q. 636 (CCPA 1970), have "severely cut back" on the application of undue multiplicity rejections. See Ibid. The holdings of both In re Flint and In re Wakefield reversed undue multiplicity rejections. Furthermore, In re Wakefield indicates that a finding in support of an undue multiplicity rejection that the number of claims is so large as to obscure the invention can be weakened by the Examiner's previous substantive examination of the claims. In the present application, all of the pending claims (except for dependent claim 241) have previously been substantively examined at least twice. Accordingly, Applicant submits that the facts of the present application should preclude an undue multiplicity rejection.

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In conclusion, the status of the pending claims, in addition to the effort expended in the previous substantive examinations thereof, is contrary to the Examiner's contention that Applicant presents an unreasonable number of claims, which are repetitious and multiplied, the net result of which is to confuse rather than to clarify. Accordingly, Applicant respectfully submits that the undue multiplicity rejection under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Examiner reconsider the outstanding undue multiplicity rejection under 35 U.S.C. § 112, second paragraph, in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: March 30, 2007By: 

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TABLE 1

STATUS OF CLAIMS PRIOR TO PRE-APPEAL BRIEF CONFERENCE BASED ON OFFICE ACTION DATED DECEMBER 27, 2005									
Independent	Claim 95	Claim 102	Claim 108	Claim 114 ALLOWED	Claim 115 ALLOWED	Claim 131 ALLOWED	Claim 138 ALLOWED	Claim 139	Claim 237 ALLOWED
Dependent	96		129	151	171	201		228	
		106	133	155	175	203		230	
	98		136	158	178	206		233	
			109	141	161	181		209	
			110	142	162	182		210	
			111			183		211	
			112			184		212	
			113			185		213	
			116	145	165	188		216	
			117	146	166	189		217	
			118			190		218	
			119			191		219	
			120			192		220	
			121			193		221	
			122			194		222	
			123			195		223	
			124			196		224	
			125	147	167	187		225	
			126	148	168	188		226	
			127	149	169	189		227	
			128	150	170	200			
			130	152	172				
			132	154	174	202		229	
			135	157	177	205		232	
			137	159	179	207		234	
				143	164				
				153	173				
				156	176	204		231	
				160	180	208		235	
						186		214	
						187		215	
									238
									239
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